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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,914	07/16/2003	Christoph Benning	MSU-07769	8436

7590

10/30/2006

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EXAMINER

BAGGOT, BRENDAN O

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/620,914	Applicant(s) BENNING ET AL.	
	Examiner Brendan O. Baggot	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-12,15-24 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,13,14,25 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) 1,2,5-12 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction / Election

1. The Office acknowledges the receipt of Applicant's response, filed 18 August 2006. Applicant traverses the restriction again, stating that searching a database takes only minutes, the Examiner suggests that the USPTO has the authority to ignore the law at the discretion of an Examiner's "personal opinion" as to what constitutes a lack of Office resources, and that the Office's reply embodies a new policy which modifies established MPEP policies and practices. Applicant's traversals have been carefully considered but are deemed unpersuasive for reasons of record. Office resources do not allow database searches against the various databases of more than one independent sequence. Applicant is respectfully reminded that he may petition the Director's Office for reconsideration of the Restriction Requirement. 37 CFR 1.144.

Claims 1-30 are pending. Claims 3, 4, 13, 14, 25, and 30 are withdrawn. Claims 1, 2, 5-12, 15-24, 26-29 drawn to SEQ ID NO: 44 encoding SEQ ID NO:45, are examined in the instant application. This action is made FINAL. All previous rejections not addressed below have been withdrawn.

Claim Objections

2. Claims 1, 11 and 21 contain language drawn to non-elected sequences. Non-elected subject matter, e.g., "selected from the group . . .", should be cancelled from the claims. Claims 2, and 5-12, dependent from Claim 1, are also objected to.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. §112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21, 26 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

4. In Claims 21 and 26, "capable of synthesizing" is unclear in that it is unclear under what conditions would the Claimed element be "capable of synthesizing." The Examiner respectfully suggests substituting "which synthesizes" for "capable of synthesizing".

Clarification and/or correction are required.

Claim Rejections - 35 U.S.C. §112, first paragraph, written description

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 21-24, 26-29 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Accordingly, Claims 21-24 and 26-29 remain rejected for reasons of record.

Applicant traverses primarily that . . . written description requirements are not limited to a representative number of species . . . and that written description may also be fulfilled by common structural features as recited by high stringency hybridization to SEQ ID NO: 44 and/or SEQ ID NO: 49. Applicant's traversals have been fully considered but are not persuasive because, Applicant does not disclose a representative number of species within the claimed genus as specified by hybridization conditions or 95% sequence identity. One skilled in the art would not be able to reliably predict the structures of other species claimed based upon the disclosure of SEQ ID NO: 44. Accordingly, this rejection is maintained.

Remarks

7. No claim is allowed. Claims 1, 2, 5-11, and 15-20 are objectionable for reciting a nonelected invention but would be allowable if rewritten without the nonelected sequences. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

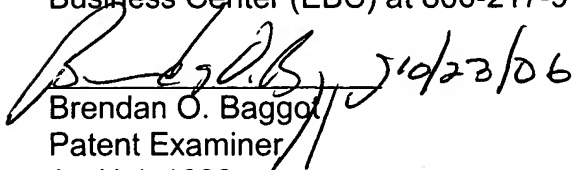
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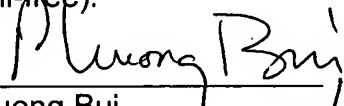
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brendan O. Baggot whose telephone number is 571/272-5265. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571/272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brendan O. Baggot
Patent Examiner
Art Unit 1638


Phuong Bui
Primary Examiner
Art Unit 1638

10/23/06

bob